

DOCKET NO.: MSFT-2835/306097.01
Application No.: 10/722,987
Office Action Dated: December 13, 2007

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

This is a full and timely response to the final Office Action mailed December 13, 2007. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

A. Present Status of Patent Application

Claims 1-7, 10-12, 25-28, 30-32, and 34-43 are now pending in the present application. Specifically, claims 2-4, 6-7, 10-12, 26-28, 30-32, and 34-36 are original unamended claims; claims 1 and 5 have been previously presented; claims 8-9, 13-24, 29, and 33 are canceled; claim 25 is currently amended without introduction of new matter; and claims 37-43 are new claims being submitted without introduction of new matter.

Reconsideration and allowance of the application and presently pending claims are respectfully requested.

B. Claim Rejections under 35 U.S.C. §103

Statement of the Rejection

Claims 1-7, 10-19, 22-32, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green (US Patent App. Pub. No. 2002/0129012 A1, published: September 12, 2002), in view of Beach et al. (Beach hereinafter) (US 2003/0014753 A1), and further in view of Peter J. Tsakanikas (Tsakanikas hereinafter) (US 4,427,848).

Response to the Rejection

Claim 1

The MPEP provides several guidelines for rejecting a claim under 35 U.S.C. 103(a). Specifically, reference is made to MPEP § 2141. III Rationales To Support Rejections Under 35 U.S.C. 103, which states in part:

“Office personnel must explain why the differences(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. ... The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that

“[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.” (Emphasis added)

Additionally, the Examiner should explain how to combine the references, per MPEP 706.02(j).

“35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation >as to< why >the claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made**.” (Emphasis added)

In the context of the rejection of claim 1, Applicant respectfully draws attention to Page 5 of the current rejection wherein the Office action asserts: “*It would have been obvious to one of ordinary skill in the art at the time invention was made to incorporate Tsakanikas’s teachings to the system of Green/Beach. Skilled artisan would have been motivated to do so, as suggested by Tsakanikas (Col. 3, lines 15-19, Tsakanikas), to lessen the chance of miskeying a character*” (emphasis added). Applicant respectfully draws attention to text in Tsakanikas that precedes “*the chance of miskeying a character.*” Upon including this preceding text, Tsakanikas discloses: “*More particularly, in accordance with one aspect of the invention, a first new translation technique is provided whereby characters are represented using only two different keys, thus lessening the chance of miskeying a character*” (emphasis added).

Tsakanikas elaborates upon this two key aspect in his col. 3, lines 19-25, which cites: “*The alphabetic characters are transmitted by depressing a designated key (e.g., *) a number of times equal to the relative position of the inscription of the character on the key (i.e., the placement division of the alphabetic character), followed by the depression of the key on*

which the character is inscribed.” Clearly, Tsakanikas lessens the chance of miskeying by using two different keys. The Office action fails to explain why or how one of ordinary skill in the art would be motivated to seek such a solution because neither Green nor Beach discloses any problems associated with miskeying.

Consequently, Applicant respectfully asserts that the rejection fails to satisfy the criteria necessary to establish a *prima facie* case of obviousness.

The rejection also fails to satisfy the criteria of a *prima facie* case of obviousness because the proposed combination would not result in a reasonable expectation of success. Per MPEP § 2143, “Office personnel must articulate [that] … a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success”. To explain, attention is drawn to Page 4 (lines 1-3) of the Office action which alleges: “*Green also discloses: the input device, and unique subset of an alphabet (Page 2, [0026], lines 1-10, “and associates each word with a unique identifying number…”* Applicant acknowledges that Green does indeed associate certain words with corresponding numbers as disclosed in his paragraph [0026]. However, such a word-to-number association is carried out in Green by using a “*lexicon 22 stored on the disk 18. The lexicon 22 contains words extracted from the collection of documents 14 and associates each word with a unique identifying number”* (lines 1-4 of Green’s cited paragraph [0026]).

Applicant respectfully asserts that one of ordinary skill in the art would not be reasonably motivated to replace a lexicon with a keypad. Consequently, the Office action assertion justifying the combination of Tsakanikas with Green/Beach appears unreasonable and illogical. It may be also pertinent in this matter to draw attention to the fact that it is legally impermissible to use hindsight gained from Applicant’s own disclosure.

In addition, Tsakanikas’s alphanumeric key structure (e.g., one which associates the number “2” with the alphabet subset “abc,” or the number “9” with the alphabet subset “wxy”) would be incompatible with Green’s invention. Drawing attention to Green’s Figs. 4-6, it can be seen that substituting the numeric value “2” for the alphabet “a” (or “b” or “c”) will not be appropriate and therefore the combination of Tsakanikas with Green fails to provide a reasonable expectation of success.

Applicant further asserts that a *prima facie* case of obviousness has not been established because the combination of references do not teach all claim limitations.

Specially, the combination of references fails to disclose or suggest “*receiving a character, appending said character to previously received characters if any,*” followed by a prefix search of received characters. In contrast, the Office action cites a portion of Green that refers to adding a word number to an array after using a lookup table.

In this matter, Green discloses in his page 6, [0050], lines 14-17, (cited in the Office action) that: “*If any bit is set to 1, the single word number that resulted in the 1-bit is included in the converted version of the target set 32, as by adding the word number to the array NUMLIST (step 167).*” Applicant draws attention to Green’s paragraph [0043] which discloses further particulars in this matter. Specifically, a relevant portion of Green’s paragraph [0043] cites: “*The match value may be boolean, indicating whether the entire character set is contained in an associated target word, or may be numeric, such as a count indicating the number of selected characters matched in a particular target word. Before passing the refined target set to the string comparison module 36, the refining procedure 76 converts the bit string representation of the target set 32 into an array NUMLIST consisting of the actual word numbers remaining in the target set 32.*” In light of this teaching in Green, Applicant respectfully submits that Green does not reasonably disclose the portion of Applicant’s claim 1 which cites: “*receiving a character, appending said character to previously received characters if any*”.

In summary, for at least the reasons provided above, Applicant respectfully asserts that the rejection of claim 1 under 35 U.S.C. 103 is improper and hereby requests withdrawal of the rejection followed by allowance of claim 1.

Claims 2-7 and 10-12

Applicant respectfully submits that independent claim 1 is allowable for at least the reasons cited above. Consequently, claims 2-7 and 10-12 that are dependent directly or indirectly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Applicant hereby requests withdrawal of the rejection followed by allowance of claims 2-7 and 10-12.

Claims 13-24

Applicant has currently canceled claims 13-24 and respectfully submits that the rejection of these claims has been rendered moot as a result of the cancellation.

Claim 25

In contrast to claim 1, which is a method claim, Applicant's claim 25 is a system claim. Consequently, the scope of these two claims is distinct and different. However, certain remarks made above with reference to the rejection of claim 1 are equally pertinent to the rejection of claim 25 as well. In the interests of brevity, these remarks will not be repeated herein and Applicant respectfully submits that claim 25 is also allowable.

Additionally, in the interests of moving forward prosecution in the case, as well as to provide focus upon certain aspects of the claim, Applicant has opted to currently amend claim 25. These amendments place claim 25 in further condition for allowance. It may be pertinent to point out that Applicant's character strings (Applicant's Fig. 2; "abc", "def" etc.) each corresponds to a unique number (i.e., "2" corresponds to "abc", "3" to "def" etc., whereby the alphabet "a" corresponds to "1" and no other number). In contrast, the cited prior art of Green does not disclose such a unique number correspondence. For example, Green's Figure 4 shows number "1" corresponding to the word "and" (containing an "a") and also shows number "10" corresponding to the word "named" (containing an "a"). Consequently, the alphabet-to-number assignment specified in Applicant's claim 25 is not disclosed in Green.

Applicant hereby requests withdrawal of the rejection followed by allowance of the claim.

Claims 26-28, 30-32, and 34-36

Applicant respectfully submits that independent claim 25 is allowable for at least the reasons cited above. Consequently, claims 26-28, 30-32, and 34-36 that are dependent directly or indirectly on claim 25 are also allowable as a matter of law. Applicant hereby requests withdrawal of the rejection followed by allowance of these claims.

Claims 29 and 33

Applicant has currently canceled claims 29 and 33 and respectfully submits that the rejection of these claims has been rendered moot as a result of the cancellation.

Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

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CONCLUSION

Applicants respectfully submit that pending claims 1-7, 10-12, 25-28, 30-32, and 34-43 are allowable. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative at (215) 568-3100.

Date: March 12, 2008

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